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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,238	07/14/2003	Alexandre Bronstein	BRONSTEIN.002	5820

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EXAMINER

HOEL, MATTHEW D

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/619,238

Applicant(s)

BRONSTEIN, ALEXANDRE

Examiner

Matthew D. Hoel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

2. A person shall be entitled to a patent unless –

3. (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 to 4, 6, 8, 10 to 13, 15 to 16, 19, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Cartmell, et al. (U.S. pre-grant publication 2003/0110400 A1, application 10/016,477).

5. As to Claim 1: '400 teaches a human test, comprising generating a web form that enables creation of a user account for a computer-related service such that the web form poses a question that is selected to exercise a common sense reasoning capability of a human being. '400 authorizes a user to send e-mail to a particular user, and the authorization is based on a list of authorized senders to that user; this is creating an account for a computer-related service (Para. 18). '400 teaches that the authorization may be done by a Turing test (Para. 27). Fig. 5 of '400 illustrates a web page through which a sender provides authorization information (Para. 27). The question of '400 can take the form of common sense reasoning capability. The user can be asked to type in the name of an object shown on the screen (Fig. 5), or to identify an error in a sentence,

identify a word shown with its letters distorted, or to identify a word presented audibly (Para. 27). These are all examples of public Turing tests.

6. As to Claim 2: '400 teaches generating a web form that poses a question that is selected to exercise an image recognition capability of a human being (identifying flower, Para. 27).

7. As to Claim 3: '400 teaches generating a web form that poses a question that is selected to exercise a capability of a human being to recognize spoken speech (identifying audible word, Para. 27).

8. As to Claim 4: '400 teaches generating a web form that poses a question that is selected to exercise a natural language processing capability of the human being (identifying sentence error, Para. 27).

9. As to Claim 6: '400 teaches generating a web form that poses a question that is selected to exercise any combination of image recognition (typing in name of object shown on screen, Fig. 5) and spoken speech recognition (audible word of Para. 27) and natural language processing (identifying word with distorted text, Para. 27) and common sense reasoning capabilities (identifying error in sentence, Para. 27) of the human mind (asking public Turing questions of different types, asking multiple questions, Para. 27).

10. As to Claim 8: '400 teaches generating a web form that poses a question using visual communication (web page asking user to identify flower, Para. 27).

11. As to Claim 10: '400 teaches generating a stimulus that is perceptible by more than one human senses, and posing a question pertaining to the stimulus that is

selected to exercise the common sense reasoning capability (identify error in sentence, Para. 27).

12. As to Claim 11: '400 teaches generating a stimulus comprising an image (web page generating image of flower, Fig. 5, Para. 27).

13. As to Claim 12: '400 teaches generating a stimulus comprising speech communication (asking the user to identify an audible word, Para. 27).

14. As to Claim 13: '400 teaches generating a stimulus comprising a sound (asking the user to identify an audible word, Para. 27).

15. As to Claim 15: '400 teaches a computer-readable storage medium (authorization system, Para. 18) that holds a set of code that when executed provides a human test by generating a web form (public Turing test by web page, Para. 27) that enables creation of a user account for a computer-related service (authorizes a user to send e-mail to a particular user, authorization based on list of authorized senders, Para. 18) such that the web form poses a question that is selected to exercise a common sense reasoning capability of a human being (public Turing tests, Para. 27).

16. As to Claim 16: '400 teaches a set of possible questions from which the question may be selected (the system may ask many different questions, Para. 27).

17. As to Claim 17: '400 teaches an image posing the question (web page asking user to identify the flower, Para. 27, Fig. 5).

18. As to Claim 19: '400 teaches an image to which the question pertains (flower to be identified, Fig. 5, Para. 27).

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19. As to Claim 20: '400 teaches generating a sound to which the question pertains (identifying an audible word, Para. 27).

Claim Rejections - 35 USC § 103

20. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

21. Claims 7, 9, 14, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over '400 in view of Lillibridge, et al. (U.S. patent 6,195,698 B1).

22. As to Claim 7: '400 discloses all of the elements of Claim 7, but lacks specificity as to posing a question using speech communication. '400 teaches generating a web page that poses a question (Para. 27). '698, however, teaches posing a question using speech communication (Col. 9, Lines 19 to 40). '698 poses a riddle to the user using computer-generated speech. It would be obvious to one of ordinary skill in the art to apply the speech communication of '698 to the authorization system of '400. Fig. 4 of '698 is an example of a Turing question used to prevent automated scripts or programs from accessing websites. '400 uses Turing questions to block access to computer systems in a like manner (Para. 27). '400 asks the user to identify an image, in this case a flower, just like '698 asks the user to identify an image, in this case, distorted letters which would be difficult for a computer to interpret using OCR. The advantage of this combination would be to make the system user-friendlier to visually impaired individuals by posing the question via speech instead of simply via images such as web pages ('698, Col. 9, Line 35).

23. As to Claim 9: '698 poses a question using a communication that is adapted to a human having an impairment (Col. 9, Lines 29 to 35).

24. As to Claim 14: '698 measures the time taken by the subject of the test to provide an answer to the question, in this case a riddle (Col. 4, Lines 51 to 59).

25. As to Claim 18: In '698, the information includes a sound that poses the question (audible riddle, Col. 9, Lines 19 to 40).

Claim Rejections - 35 USC § 101

26. 35 U.S.C. 101 reads as follows:

27. Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

28. Claims 1 to 14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a human test, which is not statutory subject matter. The examiner believes that the applicant intends to cite a method or a process. A method for performing a human test would be acceptable as long as it is drawn to a concrete, tangible, and useful result. It would be better to cite physically outputting a question to a user, such as one of the public Turing tests of '400, Para. 27, physically accepting input from a user as to the question's answer, and deciding based on whether the answer is right or wrong to take a concrete action, such as granting the user access to a computer system. Output devices could be a visual display or speakers; input devices could be a keyboard, a mouse, or a joystick. The examiner notes that a concrete action taken as a result of the received answer would be best cited as a step executed in a method, as a preamble such as "for

creation of a user account for a computer-related service” would only be a limitation if it breathed life and meaning into the claim (MPEP 2111.02). It would be better to cite the step of “creating a user account for a computer-related service” for physically granting a user access to a computer system. Please see MPEP 2105 and the 35 U.S.C. 101 guidelines, Official Gazette, Nov. 2005 (available on uspto.gov).

29. Claims 15 to 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 15 cites “a computer-readable media that holds a set of code that when executed provides...” It is not clear whether the code is physically executed by a computer. Suggested claim language would be “computer-executable instructions stored on a computer-readable medium, that when executed provide...” The claim as currently amended could conceivably be done by a human being executing a list of steps in a Word *.doc file read from a hard drive and displayed on a computer screen. Please see MPEP 2106 and the 35 U.S.C. 101 guidelines, Official Gazette, Nov. 2005 (available on uspto.gov).

30. Claims 1 to 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims positively cite “of a human being.” Then Assistant Secretary and Commissioner of Patents and Trademarks, Donald J. Quigg, issued a notice in the Official Gazette stating, “A claim directed to or including within its scope a human being will not be considered to be patentable subject matter under 35 U.S.C. 101. The grant of a limited, but exclusive property right in a human being is prohibited by the Constitution.” 1077 OG 24 (1987), reprinted in 1146 TMOG 24 (1993). Physically outputting a question to a user by an output device,

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physically accepting an input from the user by an input device, and making a decision as to the user's "common sense reasoning capability" to take a concrete or physical action or to decide what to physically display back to the user based on his or her answer, would be acceptable as long as the method involved a physical transformation or were drawn to a concrete, tangible, and useful result. It is important that a human being or any part thereof is nowhere cited as part of an apparatus or a system. It is generally better to cite "player" or "user" instead of "person," "human," or "human being." See for example the claims of U.S. patent 7,070,501 B2. Please see MPEP 2105 and the 35 U.S.C. 101 guidelines, Official Gazette, Nov. 2005 (available on uspto.gov).

Response to Arguments

31. Applicant's arguments with respect to Claims 1 to 20 have been considered but are moot in view of the new ground(s) of rejection. The applicant states that Claims 1 to 20 pertain to a practical application in the technical arts, and so are statutory subject matter. The examiner notes that the "technological arts" test is no longer used. Claims 1 to 20 are in better condition than when originally submitted, but are still not statutory subject matter. Method claims must have a physical transformation or a concrete, tangible, and useful result (35 U.S.C. 101 guidelines, Official Gazette, Nov. 2005, available on uspto.gov). The examiner interpreted "common sense" as broadly as reasonable without reading the limitations of the specification into the claims. The examiner believes that the public Turing tests of '400 test common sense. The example cited in Fig. 2 of the application is an enabling, rather than a limiting, example of

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common sense. The user is asked if a horse can jump over a fence or fly over a mountain. These questions ask simply whether or not something is possible, which is only one aspect of common sense. The examiner respectfully disagrees with the applicant as to the claims' condition for allowability.

Citation of Pertinent Prior Art

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Von Ahn, et al. in "Telling Humans and Computers Apart (Automatically) or How Lazy Cryptographer do AI" teach public Turing tests that measure common sense (Page 3).

Conclusion

33. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

34. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

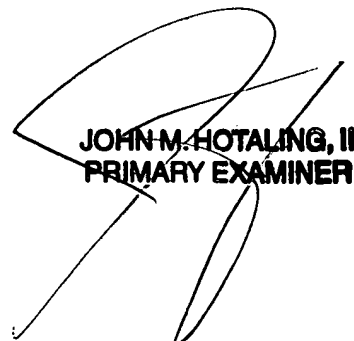
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Hoel whose telephone number is (571) 272-5961. The examiner can normally be reached on Mon. to Fri., 8:00 A.M. to 4:30 P.M.

36. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

37. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew D. Hoel, Patent Examiner
AU 3713


JOHN M. HOTALING, II
PRIMARY EXAMINER